



**UNITED STATES DEPARTMENT OF COMMERCE**  
**United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/003,003 01/05/98 DIETZ

M 017096-00021

EXAMINER

QM12/0410

GUY W CHAMBERS  
TOWNSEND AND TOWNSEND AND CREW  
TWO EMBARCADERO CENTER 8TH FLOOR  
SAN FRANCISCO CA 94111-3834

WHITE, C

ART UNIT

PAPER NUMBER

3713

DATE MAILED:

04/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	<b>Application No.</b> 09/003,003	<b>Applicant(s)</b> DIETZ, MICHAEL J. II	
	<b>Examiner</b> Carmen D. White	<b>Art Unit</b> 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 January 2001.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- |   |  |
|---|--|
| 15) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 20) <input type="checkbox"/> Other: _____                                    |

Art Unit: 3713

## DETAILED ACTION

### ***Terminal Disclaimer***

The terminal disclaimer filed on May 8, 2000 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 5,704,835 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dabrowski et al in view of Manship et al.

Regarding claim 1, Dabrowski et al discloses a video poker electronic gaming system that includes having a plurality of symbols arrayed in multiple columns; selecting initial card symbols to be arrayed; displaying the initial card symbols selected in an array on the monitor; designating chosen symbols, from none to all, for replacement; selecting replacement card symbols; replacing the initial card symbols on the monitor with replacement symbols; and determining whether the replacement symbols and any remaining initial symbols constitute a winning combination and rewarding a winning combination (Fig. 1; col. 5, lines 18-28). Dabrowski et al lacks disclosing the card

symbols being arrayed in multiple rows. However, in an analogous video gaming machine, Manship et al discloses the arraying of symbols in multiple rows and columns. It would have been obvious to a person of ordinary skill in the art to arrange the card symbols of the two draw poker card hands of Dabrowski et al in multiple columns and rows, as taught by Manship et al, as a matter of design choice. It is well known in video slot machines to arrange symbols in multiple columns and rows to increase the player's chances of obtaining winning combinations.

Regarding claims 2-9 and 11-17, Dabrowski et al in view of Manship et al discloses all the limitations of the claims as discussed above. Dabrowski further discloses a draw poker gaming system that includes allowing the player to replace card symbols to be replaced by other random card symbols from a stored plurality of card symbols (deck of card symbols). The player has the option to draw and discard card symbols until the player is satisfied with the final group of card symbols (final hand). These are common features of a draw poker gaming system.

Regarding claim 10, Dabrowski et al in view of Manship et al discloses all the limitations of the claims as discussed above. Manship et al further teaches the evaluation of symbols across one or more columns to determine winning combination of symbols (col. 5, lines 13-28 and Fig. 2).

Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dabrowski et al in view of Manship or Bennett (6,056,642).

Regarding claims 18 and 19, Dabrowski et al in view of Manship et al or Bennett discloses all the limitations of the claims as discussed above. Dabrowski et al lacks

Art Unit: 3713

disclosing the feature of allowing the player to select background colors and replace background colors of symbols. However, Manship or Bennet teaches that slot machine play can be enhanced by changing background colors of symbols. Manship discloses the changing of background colors of the symbols in order to increase the video slot machine's appeal to the player. Bennett also discloses the changing of the background of symbols to increase the payout value of the combination of winning symbols (abstract). It would have been obvious to a person of ordinary skill in the art to incorporate the changing of symbol background color as taught by Manship et al or Bennett in the system of Dabrowski et al in order to enhance the symbol replacement system of Dabrowski et al to further allow the player to increase winning combination outcomes.

Claims 20-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dabrowski et al or Heidel et al (5,342,047) in view of Manship et al.

Regarding claims 20-23, 25 and 29-30, Dabrowski et al or Heidel et al discloses an electronic gaming apparatus that includes a monitor for displaying a plurality of symbols arrayed in multiple columns; a memory that stores a list of possible symbols (deck of card symbols); a microprocessor to select symbols from the memory for display on the monitor to determine whether a final group of displayed symbols creates a winning or losing game; a first button to initiate game play and a second button to allow the player to choose replacement symbols from none to all of the initial card symbols and have the microprocessor randomly select replacement card symbols from a list of possible card symbols stored in memory and display the replacement card symbols

together with any remaining initial card symbols to create a final group of symbols (hand of cards) [Dabrowski et al- Fig. 1, #62; #60; col. 5, lines 17-28; Heidel et al- Fig. 1; col. 2, lines 51-66)]. Heidel further discloses an embodiment where the video gaming machine can be used to display symbols in multiple rows and columns (Fig. 2a).

Dabrowski et al lacks disclosing the card symbols arranged in multiple rows. Manship et al discloses this feature (see above claim rejection for explanation and motivation).

Regarding claims 24 and 26, Dabrowski et al or Heidel et al in view of Manship et al discloses all the limitations of the claims as discussed above. Manship et al further discloses the symbols having the appearance of reels of a slot machine (Fig. 2). Heidel also discloses the display of symbols with the appearance of reels on a slot machine (Fig. 2a).

Regarding claims 27-28, Dabrowski et al or Heidel et al in view of Manship et al discloses all the limitations of the claims as discussed above. Heidel et al further discloses the use of a touch screen controls (abstract; Fig. 1)

### ***Examiner's Response to Applicant's Remarks***

Applicant argues that the instant claimed invention is not directed to a video poker game as is disclosed by Dabrowski. However, the examiner asserts that the instant invention, ***as it is currently claimed***, reads on an electronic draw poker game. Applicant goes on to argue that the Manship reference, which the examiner has cited to show the feature of multiple rows and columns of symbols, does not teach the individual symbol respin capabilities of the current invention. However, Applicant has not provided this feature as a claim limitation in the instant claims. In response to applicant's

Art Unit: 3713

argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., individual symbol respin) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding Applicant's argument that Manship nor Bennett discloses the feature of allowing the player to select one or more symbols or colors for replacement. Applicant is arguing the references separately. The examiner has combined Manship and Bennett with Dabrowski to reject this limitation of the claims. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant has based his argument for patentability on the "respin" capability that has not been claimed. The examiner has provided logical reasoning in the rejection of the instant claims (see above). The addition of the feature of allowing the player to select from none to all of the symbols to be replaced is a well known aspect of draw poker games. Dabrowski teaches this feature in which the player can choose a number ranging from none to all of the cards to be replaced in order to increase the chances of having a winning hand.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

***USPTO Contact Information***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen D. White whose telephone number is 703-308-5275. The examiner can normally be reached on Monday through Friday, 8:30 AM to 5:00 PM.

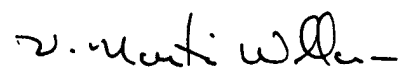
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703-308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7768 for regular communications and 703-305-3579 for After Final communications.



Art Unit: 3713

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.

  
Carmen White  
Patent Examiner

  
VALENCIA MARTIN-WALLACE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700